

REMARKS

Claims 1-4 and 10-15 are pending in the present application.

Claim 1 has been to overcome the Examiner's 35 USC 112 rejection. No new matter has been added by the amendment of claim 1.

Interview Summary Record

Applicant's representative gratefully appreciates the Examiner's consideration during the Interview on April 18, 2002. The claims have been amended consistent with the discussions during the Interview. Further, arguments presented during the Interview have been incorporated into the remarks herein below.

Issues Under 35 USC 112

Claims 1-4 and 10-15 have been rejected under 35 USC 112, first paragraph, because the specification, which being enabling for making alcoholic wine liquor, does not reasonably provide enablement for the reproduction of coffee flavor for an extraction residue. Applicants have amended claim 1 to recite "production of an alcoholic coffee wine drink" which was cited in the original claims. Agreement was reached during the Interview that the amendment to claim 1 would overcome the 35 USC 112, second paragraph rejection. Therefore, it is submitted that claims 1-4 and 10-15 comply with all requirements under 35 USC 112, such that the above-noted rejection should be withdrawn.

Issues Under 35 USC 103(a)

Claim 1-4, 10, and 12-15 are rejected under 35 USC 103(a) as being unpatentable over Papazian in view of Rizzi, et al. (U.S. Pat. No. 5,008,125).

Claim 11 is rejected under 35 USC 103(a) as being unpatentable over Papazian in view of Rizzi, et al. and in further view of Suzuki (U.S. Pat. No. 3,845,220).

The Present Invention and its Advantages

The present invention according to claim 1 relates to a process for the production of an alcoholic drink having coffee flavor from an extraction residue of roasted coffee beans, which comprises adding a saccharide to an extraction residue of roasted coffee beans and fermenting the resulting mixture in the presence of wine yeast for the brewing of an alcoholic wine liquor.

As shown by the nine examples on pages 5-26 of the present specification, an alcoholic wine drink having the rich aroma and taste of coffee is prepared by the present invention using various extraction residues of roasted coffee beans. Specific examples thereof include an extraction residue left after roasted coffee beans or a ground product thereof is extracted with hot water or an aqueous solution of an alcohol such as methanol or ethanol; and an extraction residue left after a hot water extract of roasted coffee beans is further extracted with an aqueous solution of an alcohol such as methanol or ethanol.

Distinctions between the Present Invention and Papazian in view of Rizzi, et al. (Claims 1-4, 10, and 12-15)

Papazian discloses a process for producing home brew that is flavored with fresh roasted coffee beans. Papazian only discloses addition of freshly ground coffee to a particular type of alcoholic beverage (Blue Mountain Stout). Papazian fails to disclose a process for producing an alcoholic drink having a rich aroma and taste of coffee by adding saccharide to the extraction residue beans and fermenting the resulting mixture in the presence of wine yeast for the brewing of alcoholic wine liquors. Specific examples thereof of the invention include a residue left after roasted coffee beans or a ground product thereof is extracted with hot water or an aqueous solution of an alcohol such as methanol or ethanol; and a residue left after a hot water extract of roasted coffee beans is further extracted with an aqueous solution of an alcohol such as methanol or ethanol. There is no disclosure or suggestion in Papazian of fermenting (with any type of yeast, with or without hops, etc.) an extraction residue of roasted coffee. Therefore, it is submitted that significant patentable distinctions exist between the present invention as a whole and Papazian and accordingly is not obvious to a person of ordinary skill in the art in view of Papazian.

The failure of the Papazian reference to render obvious Applicants' claimed alcoholic drink having coffee flavor is not overcome by the disclosure of Rizzi, et al.

Rizzi, et al. teaches the use of defatted spent coffee grounds to absorb bitter coffee flavors and burnt coffee aromas. The spent coffee is considered to be cheap, unadulterating, and tasteless and, therefore, according to Rizzi, et al., are useful as an additive for roast coffee grounds, preferably low quality coffee or blends containing low

quality coffee where bitter flavors and burnt aromas are often undesirably strong. The defatted spent coffee grounds (DFG) additive are spent coffee grounds that contain 0 to about 2% lipids and are extracted, defatted, and dried coffee grounds.

While DFG's may be tasteless and inexpensive absorbents they are not taught to
be useful as a source of a coffee beverage or substitute for coffee beans in a fermentation process to make an alcoholic coffee flavored wine drink.

Therefore, neither Papazian nor Rizzi, et al. either alone or in combination teach or suggest Applicant's claimed invention. In addition, there fails to be any adequate basis for a motivation to one skilled in the art to combine the references leading to their combination as relied on by the Examiner.

Furthermore, Papazian uses the highest quality coffee beans in his brewing process, which clearly teaches away from Applicants' invention of using an extraction residue of roasted coffee beans. One important addition of non-obviousness is "teaching away" from the claimed invention by the prior art. *In re Pratt*, 16 USPQ2nd 1813 (Fed. Cir. 1990).

During the Interview, the Examiner repeated his reliance on *In re Lavin* cited by the Examiner on page 5 of the Office Action mailed November 5, 1999.

The *In re Lavin* decision is not applicable to the facts of this application. The invention claimed in *In re Lavin* relates to a butter substitute food product containing well-known ingredients such as butter fat, egg yolk and edible acids with no apparent coaction between the ingredients. *In re Lavin* concerns a simple mixture of well-known

ingredients whereas the present invention involves ingredients that undergo an alcoholic fermentation process using extraction residues of roasted coffee beans in which the nature of the ingredients are changed. The extraction residue of roasted coffee beans is not a known ingredient in a process for fermenting wine. The extraction residue of roasted coffee beans is normally thrown away. In the present invention, the extraction residue of roasted coffee beans and the other ingredients undergo a coaction with each other during the fermentation process in which the nature of the ingredients are changed to produce a product which is materially different from the properties which the several ingredients individually do not possess in common.

Distinctions between the Present Invention and Papazian in view of Rizzi, et al. and in further view of Suzuki (Claim 11)

Suzuki, a secondary reference, is relied upon to teach the use of enzymes to modify the foaming properties of the coffee carbonated beverage. Therefore, Suzuki does not obviate deficiencies of the primary combination of Papazian and Rizzi, et al.

The disclosure of using an enzyme as an antifoaming agent can hardly be said to be relevant to the disclosure of Papazian. First, the foaming problem addressed by Suzuki involves foaming of a carbonated liquid beverage when the beverage is dispensed into a glass from a pressurized vessel and not foaming during fermentation. Papazian certainly is not concerned with and does not teach or suggest adding a carbonated liquid to a coffee flavored beverage.

In the process of the present invention, the addition of hydrolase enzyme as recited in claim 11 is for the purpose of hydrolasing polysaccharide proteins in the extraction coffee residue. This is explained on page 3, lines 14-17, of the specification. The inventor explains that the function of hydrolyzed treatment is to facilitate the assimilation of yeast by the coffee grounds. Therefore, the function of hydrolase treatment in the present invention is for a clearly different purpose than the enzyme treatment taught by Suzuki.

Modifying Papazian in order to obtain the claimed invention is a hindsight reconstruction of the prior art in view of Applicants own disclosure, which is an improper basis. *In re Geiger* 2 USPQ2nd 1276 (Fed. Cir. 1987). There is no suggestion in Papazian to use extraction residue of roasted beans in the manner of the present to obtain an alcoholic drink having a rich aroma of coffee.

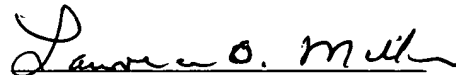
Thus, the Papazian, Rizzi, et al., and Suzuki references fail to support the alleged *prima facie* obviousness.

Furthermore, Applicants disagree with the Examiner's position in paragraph 8 of the Office Action that "no data is presented that using any and all amounts of a coffee residue will reproduce the coffee flavor". Example 9 on page 25 of the specification shows a specific example of a coffee flavored drink made according to the present invention from extracted residue of roasted coffee beans that have been extracted with hot water. The other eight examples use spray dried or dry powder extraction residue of roasted coffee beans that have been extracted with hot water and/or an aqueous solution of an alcohol such as methanol or ethanol.

In the present invention, however, the amount of extraction residue of roasted coffee beans which are subjected to alcohol fermentation is not an essential parameter, but can be varied according to the degree of coffee flavor which is required of the resulting alcoholic drink. The Examples of the present specification show results of alcohol fermentation of various extraction residues of roasted coffee beans that have been extracted with hot water or an aqueous solution of an alcohol such as methanol or ethanol or a residue left after hot water extraction and further extraction with an aqueous solution of an alcohol such as methanol or ethanol.

It is submitted that in view of the amendment to claim 1 and the accompanying Remarks it is believed that all of the presently pending claims define patentable subject matter such that the present invention should be placed into condition for allowance.

Respectfully submitted,
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Serial No. 08/950,902

MARKED-UP VERSION OF AMENDED CLAIM

Claim 1. (Thrice amended) A process for the [re-production of coffee flavor]
production of an alcoholic drink having coffee flavor from an extraction residue of
roasted coffee beans, which comprises adding a saccharide to [an] the extraction residue
of roasted coffee beans and fermenting the resulting mixture in the presence of wine yeast
for the brewing of alcoholic wine liquors.

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